



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,779	08/06/2003	Tetsuya Otsuka	SH-0037US	7630

21254 7590 11/14/2007
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
----------	--------------

1794

MAIL DATE	DELIVERY MODE
-----------	---------------

11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/634,779

Applicant(s)

OTOSAKA ET AL.

Examiner

Michael La Villa

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,20-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,20-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The text in the title relating to method for manufacturing should be deleted to comport the title to the claimed subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
4. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-7, 9, 10, 20-26, 28, 30, and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the claim amendment relating to the outermost portion has been described in applicant's Response as existing at page 4, line 31 to page 5, line 1 of the Specification. This portion of the Specification demands that the outermost portion be a clad layer having the claimed viscosity relationship. That the outermost portion is a clad layer is not claimed in these rejected claims. It is therefore unclear how this portion of the Specification provides support for a

limitation that viscosity of the outermost portion is less than a maximum value V_0 .

The following is a quotation of the second paragraph of 35 U.S.C. 112:

6. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1-10, 20-28, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Regarding Claims 1 and 20, it is unclear what is meant by the phrase "maximum value V_0 ". It is unclear what is the relationship between the third use of the phrase and the first and second uses. With respect to the last occurrence, it is unclear which of the earlier is being referenced. It is unclear whether "maximum" means that the claimed viscosity must not exceed the maximum value or whether it means that the claimed viscosity reaches that maximum value, but not higher. Antecedent basis for V_0 , as mentioned in Claims 8, 9, and 30, is also indefinite.
9. Regarding Claim 6, it is unclear what is the antecedent basis of the phrase "maximum value V_0 ". Is this in the inner area, the outer portion, or the outermost portion?
10. Regarding Claim 28, it is unclear what is meant by the phrase "diameter of said inner clad layer." It is unclear what is the antecedent basis of "said inner clad layer" as Claim 2 references two such layers. It is unclear what is the diameter of a layer. Is this two times the radial distance from the center of the preform to the

innermost surface of the inner clad layer? Analogous rejection with respect to the meaning of layer diameter applies to Claim 30.

11. Regarding Claim 31, it is unclear what is meant by the phrases "maximum viscosity" and "maximum value V_0 ". It is unclear whether "maximum" means that the claimed viscosity must not exceed the maximum value or whether it means that the claimed viscosity reaches that maximum value, but not higher. It is unclear what is the antecedent basis for "maximum value V_0 ," if any, or whether the phrase refers to an arbitrary value.

Response to Amendment

12. In view of applicant's amendments and arguments, applicant traverses the claim objection of the Office Action mailed on 1 June 2007. Objection is withdrawn.
13. In view of applicant's amendments and arguments, applicant traverses the section 112, first paragraph new matter rejection of the Office Action mailed on 1 June 2007. The argument for support is not persuasive for the reasons in the rejection set forth above.
14. In view of applicant's amendments and arguments, applicant traverses the section 112, first paragraph enablement rejection of the Office Action mailed on 1 June 2007. Rejections are withdrawn.
15. In view of applicant's amendments and arguments, applicant traverses the section 112 rejection, second paragraph rejection of the Office Action mailed on 1 June 2007. To the extent that these rejections are not repeated above, the rejections have been overcome and are therefore withdrawn. Applicant explains

that "both the terms 'maximum value V_o ' and ' V_o ' indicate the same radial viscosity distribution." See Applicant's Response of 1 November (page 8). It is unclear what is meant by this comment. It is unclear whether "maximum" means that a certain value cannot be exceeded or that a certain largest value has been obtained. Applicant's comments and claim terminology do not clarify this issue. Furthermore, Claim 1 and other claims appear to refer to three different radial areas and corresponding viscosity values, using the same terminology "maximum value V_o " to describe each of these. It is unclear how to interpret the claim requirements relating to relative viscosity values. For example, when the outermost portion of Claim 1 is to have a viscosity "less than a maximum value V_o " what is the value below which the viscosity must be? Is this the value for the outside portion, the inside area, or something else? Furthermore, otherwise, applicant's amendments and comments do not appear to address the other rejections set forth above for the reasons given above. Therefore, these rejections are maintained.

16. Applicant is advised to use a large type font in applicant's correspondence as the subscripts are otherwise illegible.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
8 November 2007


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER